

Remarks

Reconsideration of this Application is respectfully requested.

Claims 6-14, 17 and 18 are pending in the application, with claim 17 being the independent claim. Claims 1-5 and 15 have been canceled, and claims 17 and 18 have been added.

Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Attached hereto is a marked up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

New Matter Objection

Because it was not mentioned in the Advisory Action dated April 7, 2003, it is assumed that the Certificate/Declaration filed March 26, 2003 overcame the new matter objection of the Office Action dated December 26, 2002. Acknowledgement is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-6, 9, 10 and 15 stand rejected under 35 U.S.C. §103 as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of U.S. Patent 5,290,507 to Runkle.

Claim 1 has been canceled in favor of claim 17, which is a combination of claims 1-5 and 15. Claim 17 recites that at least one of said walls is a stationary lining consisting of a ceramic

material and further states that the lining is bonded to a back support. In reference to claim 1, the Action argued the following: 1) the AAPA admits that tungsten/carbide cobalt is used as a coating on the walls, 2) Runkle teaches the use of tungsten carbide (a ceramic) as a wear resistant material, and 3) it would be obvious to use the tungsten carbide as taught by Runkle in place of the tungsten carbide cobalt admitted by the Applicants because of its wear resistance.

As articulated in the Amendment filed March 26, 2003, Applicants maintain that there would be no motivation to combine AAPA and Runkle and that the disclosure of Runkle teaches away from the combination.

It is not clear how the Examiner proposes to modify AAPA with Runkle. If the rejection proposes to merely use tungsten carbide instead of tungsten/carbide cobalt, then the rejection ignores the actual teachings of Runkle. There is no motivation to modify AAPA in this manner. If the fair teachings of Runkle are incorporated into AAPA, then the resulting apparatus fails to read on the claim recitations.

There is no motivation to combine Runkle and AAPA. As noted by the Examiner, Runkle states "carbide compositions (carbides), for example tungsten carbide (a ceramic) or the cemented tungsten carbide cobalt (a cermet) have outstanding wear resistance." However, immediately following this statement, Runkle continues: "However, these carbides are usually too brittle to be used as structural elements (which must possess the ability to withstand impact).

In this regard, it is important to note the specific teachings of the AAPA. The pertinent part of the specification states on page 5, "the stationary walls...include the coating of such walls with a steel paneling which is coated with tungsten carbide/cobalt." In this way, the coating of tungsten carbide/cobalt acts, in effect, as a structural element. The coating must also be able to withstand impact. Runkle states that the carbides are too brittle to be used as structural elements and too brittle to withstand direct impact. The further teachings of Runkle do not dispute this disclosure.

In Runkle, a carbide powder is mixed with a steel alloy powder to form a mixed powder mass which is compacted and bonded to the steel substrate. (see, for example, col. 1, lines 51-63). This mixing of powders and isostatic cladding process are necessary to prevent the brittleness of the carbides. (col. 5, lines 38-41). Therefore, one skilled in the art, when viewing Runkle and AAPA would expect that merely substituting tungsten carbide cobalt with tungsten carbide, as presumably proposed by the Action, would result in a disadvantageous brittle lining. Accordingly, one skilled in the art would not combine the references as proposed.

If the isostatic process of Runkle is used in the apparatus of the AAPA, then the resulting apparatus does not meet the claimed limitations. Claim 17 requires that the lining bonded to the back support consist of a ceramic material. "Consist" is a closed term that excludes any additional material. Thus, the mixture of carbide and steel alloy powders as taught by Runkle would not read on this claimed feature.

Accordingly, it is respectfully submitted that claim 17 distinguishes over Runkle and AAPA and is allowable. Claims 6, 9 and 10 depend from claim 17 and are allowable as depending from an allowable claim.

Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over AAPA in view of Runkle and GB 885,485. Claim 8 depends from claim 17. GB 885,485 fails to cure the deficiency of the rejection of claim 17, discussed above. As such, claim 8 is allowable as depending from an allowable claim. Claim 8 further distinguishes over the cited references by reciting that the ceramic material would have an "orange peel surface." The Examiner notes that GB 885,485 teaches spraying ceramic material on tools, and thus, teaches a surface with irregularities, i.e., an "orange peel." However, it is respectfully submitted that one skilled in the art would not and could not combine GB 885,485 in the manner proposed. As discussed above, Runkle teaches a process whereby carbide powder and steel alloy powder are combined to form a macrocomposite powder. This macrocomposite powder must be clad onto the substrate by hot isostatic pressing. This process is required to achieve the advantages disclosed in Runkle. (col. 8, lines 26-43). Therefore, one skilled in the art would not, and probably could not, spray the carbide composite of Runkle onto a substrate as proposed by the Examiner.

Claims 1-5, 7, 9-11, 13-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over DE 197 33 443 in view of AAPA and Runkle

AAPA and Runkle are cited for the same teachings as in the rejection of claims 1-6, 9, 10 and 15 discussed above. Claim 17 is allowable over the combination of DE 197 33 443, AAPA

and Runkle for the reasons stated above. Claims 7, 9-11, 13 and 14 depend from claim 17 and are allowable as depending from an allowable claim. These claims also recite additional features that distinguish over the cited art.

Regarding claim 7, the Examiner argues that applying the ceramic in the molten state or spraying would not structurally distinguish over the cited art. Reconsideration is respectfully requested. As noted in Runkle, a composite is isostatically bonded to the substrate. The isostatic cladding would, in fact, result in a different structure than a molten or spray bonding.

Claim 18 recites that the wall is bonded with adhesive to the back support. None of the cited art teaches this feature. Even moreso than claim 7, bonding with adhesive is a structural limitation that distinguishes over Runkle. Furthermore, AAPA does not teach bonding the lining with adhesive.

Applicants: Hans-Heinrich MÜLLER et al.
Appln. No. 09/888,651

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

A Notice of Allowance with claims 6-14, 17 and 18 is respectfully requested.

Respectfully submitted,



Date: 04/28/03

Chad C. Anderson
Registration No. 44,505
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 962-4800
Telefax: (202) 962-8300

Version With Markings To Show Changes Made

In the Claims:

Please cancel claims 1-5 and 15; amend claims 6 and 7; and add new claims 17 and 18.

6. (Amended) The conveyor of claim 17 [4], wherein said lining has a thickness in the range of between 0.05 and 0.5 mm.

7. (Amended) The conveyor of claim 17 [4], wherein said lining is applied to said back support in accordance with one of undertakings including the application in molten state and spraying.

17. (New) A conveyor for flowable particulate tobacco material of the tobacco processing industry, comprising a duct defining a path for the flowable material and having walls bounding said path for direct contact with the flowable material and forming part of a cigarette rod making machine, at least one of said walls being a stationary lining having a surface adjacent said path and consisting of a ceramic material, and

a back support for said lining, said lining being disposed between said back support and said path, wherein said lining is bonded to said back support.

18. (New) The conveyor of claim 17, wherein said lining is bonded to said back support with adhesive.